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David Allison Bennett

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID ALLISON BENNETT, LYNN SHAINDELL
GOLDHABER, LORY ELIZABETH KRETT, WILLIAM W. SMITH III,
PAUL BILIBIN, and CHARLES D. MENTZER

Appeal 2009-010039
Application 09/680,654
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

David Allison Bennett et al. (Appellants) seek our review under 35 U.S.C. § 134 (2010) of the final rejection of claims 1-21, 26-52, and 57-70. We have jurisdiction under 35 U.S.C. § 6(b) (2010).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND of rejection pursuant to 37 C.F.R. § 41.50(b).²

THE INVENTION

This invention is a computer system for parcel shipping management. Specification 1:20-21.

Claims 1 and 26, reproduced below, are illustrative of the subject matter on appeal.

1. A shipping management computer system, said shipping management computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

display to a respective user of a plurality of users, upon the respective user's request, as to a respective particular parcel to be shipped by the respective user, a respective simultaneous online interactive graphic cross-comparison of a plurality of respective service-specific, carrier-specific shipping rates, wherein the respective service-

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Aug. 31, 2006) and Reply Brief ("Reply Br.," filed Jan. 24, 2007), and the Examiner's Answer ("Answer," mailed Nov. 30, 2006).

specific, carrier-specific shipping rates are calculated and displayed for each respective service of a plurality of services offered by each respective carrier of a plurality of carriers to ship the respective particular parcel, wherein each respective service-specific, carrier-specific shipping rate is displayed adjacent a display indicating a respective time and date before which a particular respective carrier would deliver the respective particular parcel to a respective particular delivery destination via a particular respective delivery service, wherein each respective user of the plurality of users accesses the shipping management computer system using a respective user client computer device, and wherein the respective simultaneous online interactive graphic cross-comparison is displayed to a respective display device that communicates with the respective user client computer device used by the respective user.

26. A shipping management computer system, said shipping management computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

prompt a user, in response to a request by the user for a shipping rate and delivery time comparison for shipping a particular parcel, with an interactive prompt, said interactive prompt comprising a display of a plurality of cells, wherein each cell of said plurality of cells comprises an intersection of indications of a corresponding parcel delivery date and a corresponding parcel delivery time, and wherein at least one cell of said plurality of cells displays for user selection a calculated shipping rate, wherein said calculated shipping rate corresponds to a particular carrier delivering said particular parcel

at or before the corresponding delivery time on the corresponding delivery date according to a particular service offered by the particular carrier.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Kara	US 6,233,568 B1	May 15, 2001
Barnett	US 6,369,840 B1	Apr. 9, 2002

FedEx® Services, FedEx,
<http://web.archive.org/web/19970116043121/www0.fedex.com/srvice.html>
(last visited March 19, 2004). [Hereinafter, FedEx].

UPS: Service Guide, UPS,
<http://web.archive.org/web/19981206043709/ups.com/using/svc-index.html>
(last visited March 22, 2004). [Hereinafter, UPS].

The following rejection is before us for review:

1. Claims 1-21, 26-52, and 57-70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kara, UPS, FedEx, and Barnett.

ISSUE

The issue is whether claims 1-21, 26-52, and 57-70 are unpatentable under 35 U.S.C. § 103(a) over Kara, UPS, FedEx, and Barnett. Specifically, the issue is whether one of ordinary skill in the art would have been led by the combination of the prior art to simultaneous online interactive graphic cross-comparison of a respective service-specific, carrier-specific shipping rates or a display of a plurality of cells, wherein each cell of the plurality of cells comprises an intersection of indications of a corresponding parcel

delivery date and a corresponding parcel delivery time and displays a calculated shipping rate.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Kara discloses using user inputted information about a piece of mail to determine the availability of a particular delivery service and to calculate and display shipping fees for each available shipping service provider. Col. 21, l. 64 – col. 22, ll. 48.
2. Kara's Figure 8 is reproduced below.

The screenshot shows a 'Shipping Form' window with a menu bar (File, Edit, Layout, Help) and a toolbar. The form is divided into several sections:

- Origin Address:** Fields for Name (John S. Doe), Company (ABC & Co. Inc.), Address 1 (4567 Main Street, Suite 200), Address 2, City (Houston), State (TX), Zip (77007-2516), and Country (USA). Buttons for 'Add' and 'Delete' are at the bottom.
- Destination Address:** Fields for Name (Mr. John F. Smith), Company (XYZ Corp.), Address 1 (1234 Main Street, Suite 100), Address 2, City (Houston), State (TX), Zip (77007-2516), and Country. Buttons for 'Browse' and 'Print' are at the bottom.
- Urgency:** A list of checkboxes: Same day, Overnight (checked), Next day, 2 days, 3 days, and International.
- Selection & Comparison:** A list of checkboxes: US Post, Federal Express, UPS, USPS, Priority, and Economy.
- Weight:** Fields for Weight (Pounds: 1, Ounces: 12), Zone (USA), and Class (1st).
- Amount:** Fields for Amount (Amount: \$1001.680, Rate: \$0.520) and a 'Manual' checkbox.
- Buttons:** 'Ready', 'Print', 'Cancel', and 'OK' are at the bottom.

FIG. 8

Kara's Figure 8 depicts a screen which has entry fields for package information, such as weight, address, and urgency and a field for displaying a comparison of delivery services' rates.

3. Barnett describes that prior art calendaring system such as Microsoft Outlook, “do not provide a multilayered calendaring system wherein events belonging to different categories and selected by a user can be overlaid on one another in a single integrated calendar.” Col. 2, ll. 5-9.
4. Barnett describes that a user can view events in an event directory listing by clicking on a category of events. Col. 3, ll. 24-28.
5. Barnett describes that the list of events could be displayed in a week view. *See* Col. 3, ll. 38-41 and Fig. 9.
6. Barnett describes that the user can click on a button to add the event to a personal calendar and for “online ordering and purchasing of products, services, or tickets as appropriate for the particular event.” Col. 40-46.
7. UPS shows various screens on a website that describes each of UPS’s available services.
8. FedEx is a listing of available delivery services and their corresponding delivery date and time rules.

ANALYSIS

The rejection of claims 1-21, 26-52, and 57-70 under 35 U.S.C. §103(a) as being unpatentable over Kara, UPS, FedEx, and Barnett.

Claims 1-21, 25-52, and 57-70 all require a simultaneous online interactive graphic cross-comparison of a respective service-specific, carrier-specific shipping rates, a display of a plurality of cells, wherein each cell of the plurality of cells comprises an intersection of indications of a corresponding parcel delivery date and a corresponding parcel delivery time

and displays a calculated shipping rate, or a similar limitation. *See* App. Br. 11-23. To teach these limitations, the Examiner combined Barnett's calendaring system with the teachings of Kara, UPS, and FedEx related to calculating shipping rates for particular services. Answer 3-4. The Appellants dispute the Examiner's finding using Barnett's calendaring system to display calculated shipping rates for particular shipping services would have been obvious. App. Br. 27-30 and Reply Br. 7-25. *See also* App. Br. 31-54.

The Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007). (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. The operative question in this "functional approach" is "whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR*, 550 U.S. at 417.

We find that the Examiner's combination is more than the predictable use of prior art elements according to their established function. The Examiner proposes using Barnett's calendaring system to display the:

calculation of shipping rates, calculated by Kara, UPS, and FedEx, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or

purchase a system based on the calendar day and time.

Answer 4.

Kara discloses displaying calculated shipping rates for a particular service by carrier in a list. FF 1-2. UPS and FedEx do not contain any teachings as to how rates are displayed. *See* FF 7-8. Barnett describes a calendar which can be use to show different categories of events from which a user can select. FF 4-5. For example, the calendar in Barnett can show all the movies that are playing for a month. *See* Fig. 6. Barnett does teach that the user can click on links on the calendar to buy products, tickets, or servers. FF 6. However, Barnett's system does not function to compare the cost of any of the products, tickets or services that could be bought. Costs are not displayed on Barnett's calendar. Barnett's calendaring system function is scheduling. Therefore, we find that to use Barnett's calendaring system to display a comparison of costs for shipping a parcel using particular shipping services would be more than the predictable user of prior art calendaring system of Barnett according to its established function.

Accordingly, we find that the Appellants have overcome the rejection of claims 1-21, 26-52, and 57-70 as being unpatentable over Kara, UPS, FedEx, and Barnett.

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection on claims 63-70.

Taking claim 63 as representative, claim 63 recites “[a] computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality or parcels” and then

recites a series of instructions. Giving claim 63 the broadest reasonable construction, we find that claim 63 encompasses a computer program *per se*. A computer program *per se* is not directed to one of the four statutory categories of patent-eligible subject matter under 35 U.S.C. § 101.³ Further, we find that claim 14 also encompasses the computer program product being embodied on a signal. A signal also does not fit within one of the four statutory categories of patent-eligible subject matter under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Since claim 63, as we have construed it above, encompasses both a computer program *per se* and a signal, we find that claim 63 directed to non-statutory subject matter.

Accordingly, we reject claims 63-70 under 35 U.S.C. § 101 as being direct to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1-21, 26-52, and 57-70 is affirmed. We enter a new ground of rejection on claims 63-70.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

³ See U.S. Patent & Trademark Office, Interim Patent Subject Matter Eligibility Examination Instructions, Aug. 24, 2009, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf and *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. § 41.50(b)

mev

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